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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,076	01/16/2002	Dan Kikinis	P1553D2	3459

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,076

Applicant(s)

KIKINIS, DAN

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 16, 18-19 and 21 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 16, 18-19 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16, 18-19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Foladare et al., USPN 5,978,837 (hereafter referred to as Foladare).

5. Regarding claim 16, Foladare taught a system for delivering emails to a user (abstract), comprising:

a network-connected server for receiving and processing the email files (column 3, lines 1-5);

a wireless transmission facility in communication with the network-connected server, for transmitting the emails (column 3, lines 16-21); and

a portable playback device enabled to receive the emails transmitted by the transmission facility and to display the emails as text to the user (column 1, lines 18-19, column 6, lines 16-20).

6. Regarding dependent claim 18, Foladare taught the network is the Internet network (column 1, lines 29-32).

7. Regarding claim 19, Foladare taught a method for delivering multimedia files to a user (abstract), comprising the acts of:

(a) receiving and processing the multimedia emails on a network by a network-connected server (column 3, line 1-5);

(b) transmitting individual ones of the emails by a wireless transmission facility in communication with the network-connected server (column 3, lines 16-21); and

(c) receiving the wireless transmitted emails at a portable playback device and displaying the emails on a display of the playback device (column 6, lines 16-20).

8. Regarding dependent claim 21, Foladare taught the network is the Internet network (column 1, lines 29-32).

9. Claims 16, 18-19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Moon et al., USPN 6,138,146.

10. Regarding claim 16, Moon taught a system for delivering emails to a user (abstract), comprising:

a network-connected server for receiving and processing the email files (column 3, lines 61-62, column 4, lines 23-29);

a wireless transmission facility in communication with the network-connected server, for transmitting the emails (column 6, lines 35-45, column 7, lines 32-45); and

a portable playback device enabled to receive the emails transmitted by the transmission facility and to display the emails as text to the user (column 4, lines 9-16, column 7, lines 46-57).

11. Regarding dependent claim 18, Moon taught the network is the Internet network (column 4, lines 1-5).

12. Regarding claim 19, Moon taught a method for delivering multimedia files to a user (abstract), comprising the acts of:

(a) receiving and processing the multimedia emails on a network by a network-connected server (column 3, lines 61-62, column 4, lines 23-29);

(b) transmitting individual ones of the emails by a wireless transmission facility in communication with the network-connected server (column 6, lines 35-45, column 7, lines 32-45); and

(c) receiving the wireless transmitted emails at a portable playback device and displaying the emails on a display of the playback device (column 4, lines 9-16, column 7, lines 46-57).

13. Regarding dependent claim 21, Moon taught the network is the Internet network (column 4, lines 1-5).

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Narayanaswamy, USPN 6,611,358 B1: taught a system and method for transcoding a document to be transmitted to a mobile station according to the document display abilities of the mobile station.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrice Winder
Primary Examiner
Art Unit 2145

August 26, 2004

Best Available Copy